



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,724	12/24/2003	Timothy James Crossett	11884/409401	8319
23838 7590 09/16/2009 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER AMSDOLL, DANA				
ART UNIT 3627		PAPER NUMBER		
MAIL DATE 09/16/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,724

Applicant(s)

CROSSETT ET AL.

Examiner

DANA AMSDELL

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks

Claim Rejections under 35 U.S.C. 103(a)

Applicant's Remarks, filed 6/18/2009 with respect to claims 1 and 8 have been considered, and as the Applicant has respectfully stated, the prior rejection is rendered moot in view of present amendments.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The term "new reversing data records" in claims 1 and 8, is a relative term which renders the claim indefinite. The term "reverse" is not defined by the claims, the specification, although providing an example using the recited "reversing data record" still does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A definition or clarification of a "reversing data record" needs to be present in the body of the claim for one of ordinary skill in the art to make a distinct interpretation. For purposes of examination, the term will be interpreted as post dating data records, that

when added to existing records (claim 1), effectively create a 'smoothing' average of contribution over time.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Although the Applicant recites a database in claim 1, this is insufficient to tie the method steps to a particular machine, as a database can be generated by manual or mentally steps. Thus, the claims are non-statutory.

Additionally, recitation of 'automated' in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-5, 8-9, 11-12 and 17 are rejected under 35 U.S.C. 102(b) as being unpatentable over Johnson (US 2001/0039500), herein "Johnson".

6. Regarding claims 1, 8 and 15-16 directed to the same, Johnson teaches:

(a) receiving input selecting a time period for which adjustments to accounting records of an business with contributors having equity interests (§0066 – discloses 'partnerships' and §0090'-discloses 'initial contributors') are to be applied, where the time period includes time between a present time and a time of an inception of the venture (§0090),

(b) receiving input selecting one or more types of accounting records to which the adjustments are to be applied, where one type of the accounting records includes

accounting records that call for contribution (Fig. 3, step 302; and ¶0061);

(c) searching a database for accounting records that have a creation date that falls within the selected time period (¶0163)

(d) for each accounting record identified by the search, applying adjustments to the accounting records of the investment venture, including:

(i) creating new reversing data records to be added to the existing data records and to be associated with respective existing data records, which when added, reverse associated existing records based on the input received (¶0188);

(ii) creating new updated data records corresponding to records associated with the reversing data records, and based on a new equity share assignment (¶0215).

Regarding claims 2 and 9, Johnson teaches the claim dependencies, and further wherein a sum for a set of existing data records is equal and reciprocal to a sum for a set of associated reversing data records; and a sum for a set of existing data records of the first equity share assignment is equal to a sum for the new data records that are based on the new equity share assignment and of a different allocation (¶0221).

7. Regarding claims 4, 11 and 17, Johnson teaches the claim dependencies, further comprising, based on input received in (b):

(vii) creating reversing capital contribution accounting records to reverse existing capital contribution accounting records made to partner accounts in transaction records of the business with partners according to a previous equity share assignment (¶0215); and

(viii) creating capital contribution accounting records corresponding to the existing records reversed by (vii) in the partner accounts of the transaction records of the business with partners for the new equity share assignment, but recording amounts in the same proportions as in the previous equity share assignment (§0025).

8. Regarding claims 5 and 12, Johnson teaches the claim dependencies, and further comprising:

(ix) performing a correction process to create accounting records indicating, in the partner accounts of the joint venture ledger for the new equity share assignment, a difference corresponding to capital contribution between the previous equity share assignment the new equity share assignment (§0229).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 6, 7, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, in view of Macalka et al. (US 2007/00179872), herein "Malcalka".

11. Regarding claims 3 and 10, Johnson teaches the claim dependencies, and discloses an owner interest that includes firms organized as partners (§0066), yet is not specific to the feature of an inter-company ledger. However, Macalka does disclose in her system and method for sharing venture investments, the following:

(v) creating, in an inter-company ledger of the joint venture, accounting records corresponding to the accounting records created in (i), with amounts in proportions according to the previous equity share assignment (Fig. 2a, elms. 2004/206; and §0035); and

(vi) creating, in the inter-company ledger of the joint venture, accounting records corresponding to the accounting records created in (ii), with amounts in proportions according to the new equity share assignment (Fig. 2b. elms. 220/224; and §0035).

One of ordinary skill in the art would find it obvious to modify the teachings of Johnson to include the eventuality of an inter-company partnership with its corresponding ledgers, as share allocations very typically have this complexity and necessitate incorporation into the joint accounting records.

12. Regarding claims 6 and 13, Johnson teaches the claim dependencies, and further teaches performing a correction indicating a difference corresponding to capital contributions between the previous equity share assignment the new equity share assignment for identified contributors (§0225), yet is not specific to the feature of an inter-company ledger. However, Macalka does disclose in her system and method for sharing venture investments, the following:

(x) performing a correction process to create accounting records indicating, in an inter-company ledger of the joint venture for the new equity share assignment (Fig. 2b, elm. 224; and ¶0034).

One of ordinary skill in the art would find it obvious to modify the teachings of Johnson to include the eventuality of an inter-company partnership with its corresponding ledgers, as share allocations very typically have this complexity and necessitate incorporation into the joint accounting records.

13. Regarding claims 7 and 14, Johnson teaches the claim dependencies, and further performing a correction process corresponding to identified capital contributors creating reversing accounting records to reverse the accounting records (¶0229), yet is not specific to the feature of an inter-company ledger. However, Macalka does disclose in her system and method for sharing venture investments, the following: created in the inter-company ledger (Fig. 3, elm. 310; and ¶0037).

One of ordinary skill in the art would find it obvious to modify the teachings of Johnson to include the eventuality of an inter-company partnership with its corresponding ledgers, as share allocations very typically have this complexity and necessitate incorporation into the joint accounting records.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Mintz (US 7548880)

- Hinkle (US 2002/0138376)
- James (US 2003/0036988)
- Allen et al. (US 2004/0148248)
- Eder (US 2005/0119922)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA AMSDELL whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627